

Appl. No. 09/643,621
Amdt. August 11, 2003
Reply to Office action of May 12, 2003
Attorney Docket No. P11889-US1
EUS/J/P/03-1062

REMARKS/ARGUMENTS

1.) Amendments

The Applicants have amended Claim 24 to correct a typographical error. Claims 1-24 remain pending in the application. Favorable reconsideration of the application is respectfully requested in view of the following remarks.

2.) Allowable Subject Matter

The Examiner indicated that Claims 3, 4, 15 and 16 are objected to as being dependent upon a rejected base claim, but that such claims would be allowable if rewritten in independent form including the limitations of their respective base claims and any intervening claims. The Applicants thank the Examiner for the indication of allowable subject matter, but believe that the respective base claims are allowable over the art of record and, therefore, decline to so amend those claims at this time.

3.) Claim Rejections – 35 U.S.C. §112

The Examiner rejected Claim 24, under 35 U.S.C. §112, second paragraph, as lacking proper antecedent basis. The Applicants have amended Claim 24 to correct a typographical error with respect to the claim's dependency; the claim now has proper antecedent basis for its elements.

4.) Claim Rejections – 35 U.S.C. § 102(e)

The Examiner rejected Claims 1-2, 5-8, 13-14 and 17-20, under 35 U.S.C. §102(e), as being anticipated by United States Patent No. 6,327,356 issued to Malik.

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Whereas Malik fails to disclose each and every element of those claims, the Applicants traverse the rejection thereof.

Claim 1 recites:

1. A method of controlling communications with at least two calling party devices by a user of a called party device, said method comprising the steps of:
establishing a first call link between said called party device and a first calling party device;
receiving a call request to said called party device from a second calling party device;
placing said first call link on hold;
accepting said call request from said second calling party device to establish a second call link between said called party device and said second calling party device;
causing a message to be transmitted to said first calling party device while said called party device is in communication with said second calling party device, whereby said user of said called party device can communicate information to a user of said first calling party device without interrupting communications with a user of said second calling party device. (emphasis added)

The Applicants' invention is characterized by a user of a called party device causing the sending of a message to a first calling party device while the called party device is in communications with a second calling party device. Malik fails to disclose that function and, therefore, fails to anticipate claim 1.

The Examiner asserts that:

Malik further teaches causing a first message to be transmitted to the first calling party while the called party is in communication with the second calling party, whereby the called party can communicate information to the first calling party without interrupting communications with a second calling party (fig. 3; col. 5, lines 31-56, col. 9, lines 27-67; 'first message' reads on the claim 'message', 'calling party' reads on the claim 'calling party device', 'called party' reads on the claim 'called party device', 'the first calling party' reads on the claim 'user of the first calling party device' and

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'calling party' reads on the claim 'user of the calling party device').

The Examiner, however, fails to point to any teaching in Malik where a **user of a called party device causes the sending of a message to a first calling party device while the called party device is in communications with a second calling party device**. Malik discloses various options available to a calling party when a called party having call waiting is already on a call and does not answer. Malik does not disclose any communications between a called party and a first calling party if the called party places the first calling party on hold and accepts a call from a second calling party. Therefore, Malik fails to anticipate claim 1.

Independent claim 13 recites limitations analogous to those of claim 1 and, therefore, Malik also fails to anticipate that claim. Furthermore, whereas claims 2 and 5-8 are dependent from claim 1 and claims 14 and 17-20 are dependent from claim 13, and include the limitations thereof, those claims are also not anticipated by Malik. The Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claims 1-2, 5-8, 13-14 and 17-20 as being anticipated by Malik.

5.) Claim Rejections – 35 U.S.C. § 103 (a)

The Examiner rejected claims 9-10 and 21-22, under 35. U.S.C §103(a) as being unpatentable over Malik in view of U.S. Patent No. 6,498,841 issued to Bull, *et al*; claims 11 and 23 as being unpatentable over Malik in view of U.S. Patent No. 6,160,877 issued to Tatchell, *et al.*; and claims 12 and 24 as being unpatentable over Malik in view

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of Tatchell and U.S. Pub. No. 2003/0021264 by Zhakov, *et al.* The Applicants traverse the rejections.

As noted above, Malik fails to anticipate independent claims 1 and 13. The teachings of Bull, Tatchell and Zhakov fail to cure the deficiencies of Malik. Specifically, neither Bull, Tatchell or Zhakov disclose a method or apparatus that allows a user of a called party device to cause the sending of a message to a first calling party device while the called party device is in communications with a second calling party device. Accordingly, claims 1 and 13 are not obvious in view of those references, either individually or in combination. Whereas claims 9-12 are dependent from claim 1 and claims 21-24 are dependent from claim 13, and include the limitations thereof, those claims are also not obvious in view of Malik, Bull, Tatchell or Zhakov, either alone or in combination. The Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claims 9-12 and 21-24 as being obvious over Malik in view of Bull, Tatchell or Zhakov.

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CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for Claims 1-24.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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